

**REMARKS**

Claims 1-15 are pending in this application. By the Office Action, claims 1-3 are rejected, claim 4 is objected to and claims 5-12 are withdrawn from consideration. By this Amendment, claims 1, 2, 4, 5, 7, 9 and 12 are amended and claims 13-15 are added. Support for the amended claims can be found in the specification at least at page 9, lines 17-19; page 11, lines 23-25; page 13, lines 19-23, and page 15, line 23. Claims 5, 7 and 9 are amended only for minor grammatical reasons. Thus, the Amendment introduces no new matter.

The courtesies extended to Applicant's representative by Examiner Shewareged at the interview held August 12, 2003 are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicant's record of the interview.

Applicant thanks the Examiner for the indication that claim 4 would be allowable if rewritten in independent form including all of the limitations of the claims from which it depends. Applicant respectfully submits that all of claims 1-15 are allowable. In view of the foregoing amendments and the following remarks, reconsideration and allowance are respectfully requested.

**I. Restriction/Election of Species and Withdrawn Claims**

The Office Action indicates that claims 5-12 are withdrawn from consideration. Claims 5-11 are directed to the non-elected species of generic claim 1, and claim 12 is included in non-elected Group II. However, because generic claim 1 is allowable, for the reasons set forth below, and claims 2-11 are written in dependent form, Applicant is entitled to consideration of claims 1-11. Alternatively, Applicants understand that upon search, examination and allowance of the elected species (i.e., glossiness controlling), search and examination will continue as to the non-elected species within the scope of the generic claim. Because the elected claims (i.e., claims 2-4) are allowable, for the reasons set forth below,

search and examination as to the remaining species within the scope of the generic claim (i.e., claims 5-11) must continue.

In regard to claim 12, where product and process claims are presented in the same application, Applicant may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. MPEP §821.04. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. Id.

In the present application, the method claim of Group II (claim 12) includes all of the limitations of the product of Group I (claims 1-11). In particular, all of the limitations of the independent product claim 1 of Group I are incorporated into the method of Group II. Since the method claim 12 of Group II includes the limitations of the product claims of Group I, claim 12 must be rejoined with the product claims once the product claims are allowed. Because claims 1-11 are allowable, for the reasons set forth below, claim 12 should be rejoined. Applicant respectfully requests the rejoinder of claim 12.

## **II. Rejection under §102**

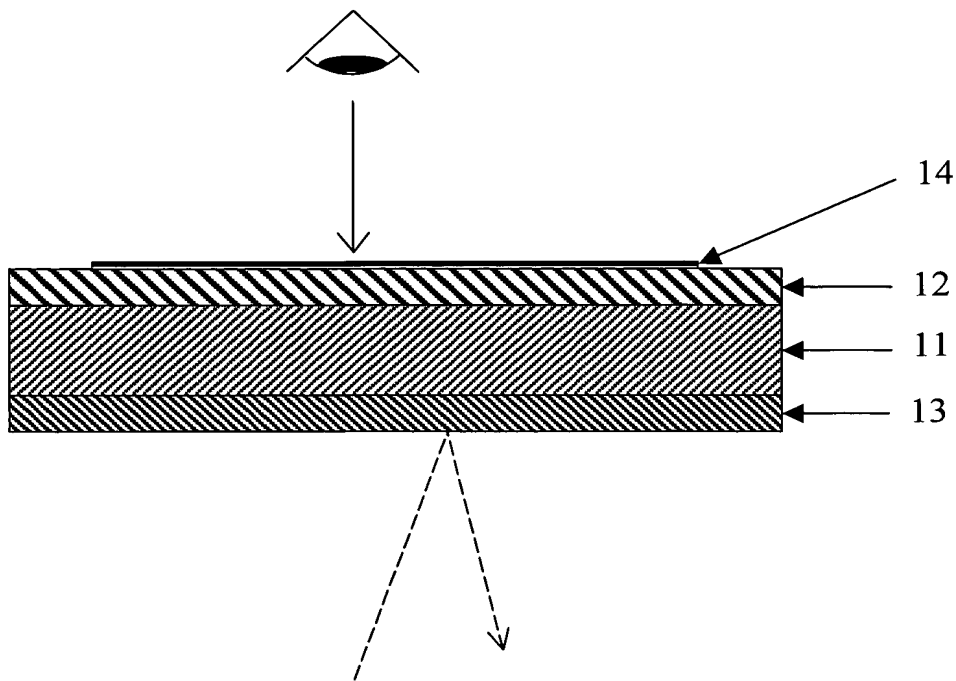
The Office Action rejects claims 1-3 under 35 U.S.C. §102(e) over U.S. Patent No. 6,214,458 B1 to Kobayashi et al. ("Kobayashi"). Applicant respectfully traverses the rejection.

Amended claim 1 is directed to an image recording material comprising a substrate having transparency, an image being formable by an electrophotography system on one side of the substrate, and a transparent characteristic controlling member provided at a side of the substrate opposite to the side where the image is formed, wherein the image can be seen when viewed through the substrate. Kobayashi does not teach such a material. In particular, Kobayashi does not teach at least "a transparent characteristic controlling member" as claimed.

Kobayashi describes an image recording sheet reportedly having high glossiness and good graininess. The sheet includes a transparent support film, a transparent image-receiving layer provided on one surface of the support film, and a white coated layer provided on the other surface of the support film (Abstract). The Office Action maintains that the white coated layer equates to a "characteristic controlling member" as originally claimed. However, in contrast to the instantly claimed "transparent characteristic controlling member," Kobayashi's white coated layer is not transparent.

Kobayashi desires to provide an image recording sheet that maintains a high glossiness that appears "close to that produced by silver-salt photography." (col. 1, lines 53-55). Kobayashi discloses a sheet that reportedly maintains high glossiness without sacrificing image quality due to graininess. The image-receiving layer of the sheet has a surface showing a glossiness of not less than 75%, and preferably not less than 80% (col. 2, lines 38-40). Kobayashi teaches that in order to give high glossiness to the image, the image recording sheet requires a highly transparent image-receiving layer, provided on a nearly opaque white coated film support (col. 1, lines 55-59 and col. 2, line 40-41). The white coated layer reportedly functions to provide a favorable effect on the quality (i.e., improved graininess) of an image (col. 3, lines 67-68).

The Figure of Kobayashi, illustrating the image recording sheet, is represented below. As described in Kobayashi at col. 3, lines 62-66, the sheet is composed of a transparent support film 11, a transparent image-receiving layer 12 provided on one surface of the support film 11, and a white coated layer 13 provided on the other surface of the support film 11. An image 14 is also shown on the surface of the image-receiving layer 12. The sheet is designed to provide for viewing the image as shown.



Importantly, Kobayashi discloses that the white coated layer is nearly opaque, having a light transmittance of less than 2%, preferably less than 1.5% (col. 21, line 26-27).

Consequently, a transmittance for rays incident from the white coated layer side of the recording sheet generally is less than 2%, preferably less than 1.5% (col. 21, lines 28-30).

This light transmittance is represented by the dashed arrow line. Because of the opaque white coating layer, the image cannot be seen when viewed from this side of the substrate.

Further evidence of the nearly complete opaqueness of Kobayashi's white coating layer is divulged in the Examples and in Tables 1-3. For instance, Kobayashi Example 1 represents an embodiment of the disclosed image recording sheet with a transparent support film and a white coated layer (col. 21, line 36 - col. 22, line 55). Comparison Example 1 is prepared utilizing a high glossy opaque film as the support film and without a white coated layer (col. 22, lines 58-64). The difference in transmittance between sheets comprising Example 1 and the reportedly opaque Comparison Example 1 is very slight, i.e., 1.0% versus 0.5% transmittance respectively (Table 1). Thus, the image recording sheet taught by

Kobayashi does not include a "*transparent* characteristic controlling member provided at a side of the substrate opposite to the side where the image is formed, wherein the image can be seen *when viewed through the substrate*", as claimed.

For at least these reasons alone, Kobayashi does not teach the claimed image recording material. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

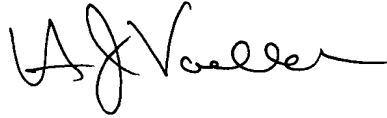
Kobayashi also fails to teach that the white coated layer, or any layer in its image recording sheet, is utilized to provide glossiness control as recited in claims 2-4. As shown in the Kobayashi Examples, printed images that utilize its image recording sheet reportedly exhibit good quality in respect to graininess, with little or no difference in respect to glossiness, compared to sheets without the white coated layer (Tables 1-3). In other words, Kobayashi discloses image recording sheets with improved graininess but without a sacrifice in glossiness. Kobayashi does not teach that the white coated layer can *control* or in any manner affect the glossiness. And even more so, as recognized in the Interview Summary sheet, Kobayashi does not teach that the white coated layer can *reduce* the glossiness, as recited in new claim 13.

For at least this additional reason, Kobayashi does not teach each and every feature of the image recording material of claims 2-4. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-15 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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JAO:HJV/hjv

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